

8-30-06

LAW OFFICES

PATZIK, FRANK & SAMOTNY LTD.

150 SOUTH WACKER DRIVE
SUITE 900
CHICAGO, ILLINOIS 60606

TELEPHONE: (312) 551-8300
FACSIMILE: (312) 551-1101



SCOTT W. SMILIE
(312) 551-3066

ssmilie@pfs-law.com

August 29, 2006

IN REPLY REFER TO:

P6755
(218728-000191)

BY EXPRESS MAIL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Re: Brief on Appeal
U.S. Patent Application No. 10/606,040
For: LATTICEWORK TRUNKING

Dear Sirs:

Enclosed for filing please find an Amended Brief on Appeal of the Final Office Action of Primary Examiner Ko Hung Chan mailed February 14, 2006 with respect to the above-referenced patent application. The enclosed Brief comprises the following:

1. Amended Brief on Appeal;
2. Certificate of Mailing by Express Mail; and
3. Postcard.

If any additional charges or fees must be paid in connection with the filing of the above Amendment, they may be paid out of our deposit account No. 50-1325. A duplicate copy of this transmittal letter is enclosed.

Very truly yours,

PATZIK, FRANK & SAMOTNY LTD.

Scott W. Smilie

Enclosures



Attorney Docket No.: P6755 (218728-000191)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: DUFOURG)

Serial No. 10/606,040)

Filed: June 25, 2003)

For: LATTICE WORK TRUNKING)

Examiner: Chan, Ko Hung)

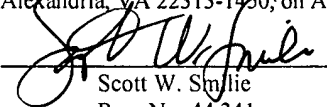
Group Art Unit: 3632)

"Express Mail" Mailing Label

No. EV064068147US

Date of Deposit August 29, 2006

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 29, 2006.


Scott W. Smilie
Reg. No. 44,341

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. REAL PARTY IN INTEREST

The application is assigned to Societe De Constructions Electriques de la Seine, 26 Rue Jean-Baptiste Potin, 92130 Issy Les Moulineaux, France.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-6 stand rejected and appealed. The claims are set forth in the CLAIMS APPENDIX hereto.

Claims 1 through 3 are grouped together and stand or fall together.

Claim 4 is not grouped with any other claim in the application and does not stand or fall with any other claim

Claims 5 and 6 are grouped together and stand or fall together

IV. STATUS OF AMENDMENTS

There have been no amendments filed subsequent to final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

This invention relates to latticework trunking or cable conduit 1 running longitudinally in a first direction and comprising at least one substantially U-shaped section that has a bottom 2 and two lateral flanges 3. (Page 4, lines 24-37). The cable conduit delimits an interior volume 4 designed to accommodate cables, pipes or lines running longitudinally in the first direction. (Page 5, lines 5-9). Further, the cable conduit comprises rigid lengthwise wires 5 running substantially parallel to the first direction and rigid crosswise wires 6 running substantially at right angles to the first direction (Page 5, lines 10-27). The lengthwise wires 5 belonging to the bottom of the cable conduit 1 each comprise a succession of longitudinal portions 5b connected by bends 5a protruding away from the interior volume 4 of the cable conduit 1. (Page 5, line 30 to page 6, line 9). Each of the bends 5a of the lengthwise wires 5 being designed to

accommodate base portions 6a of the crosswise wires 6 and being sized so that said base portions 6a of the crosswise wires 6 and the longitudinal portions 5b of the lengthwise wires 5 lie at substantially the same level. (Page 6, lines 5-9).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-3 are “unpatentable” over Simon (U.S. Patent No. 5,531,410) in view of Hatch (U.S. Patent No. 1,559,695) under 35 U.S.C. §103(a).

2. Whether claims 4-6 are “unpatentable” over Simon in view of Hatch and further in view of Yake (U.S. Patent No. 4,046,261) under 35 U.S.C. §103(a).

VII. ARGUMENT

1. Obviousness

In order to establish a prima facie case of obviousness, the examiner must show that there is “[1] some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . [2] a reasonable expectation of success.” and [3] a prior art reference or references that teach or suggest all of the claimed limitations. M.P.E.P. § 706.02(j).

In determining whether a claim is obvious over the prior art, the patent statute (35 U.S.C. § 103), the Supreme Court and the Circuit Court of Appeals for the Federal Circuit all require consideration of the subject matter of the structure of the “invention as a whole” and the problem it solves as viewed in the light of the prior art teachings at the time of the invention. *Bonito*

Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 150, 9 U.S.P.Q.2d 1847, 1851-52 (1989);
In re Ochiai, 71 F.3d 1565, 1569, 37 U.S.P.Q.2d 1127, 1131 (Fed. Cir. 1995). When determining
whether the claimed subject matter is obvious, it is well established law that

[t]o support the conclusion that the claimed invention is directed to obvious
subject matter, either the references must expressly or impliedly suggest the
claimed invention or the examiner must present a convincing line of reasoning as
to why the artisan would have found the claimed invention to have been obvious
in light of the teaching of the reference.

M.P.E.P. § 706.02(j) (quoting *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. &
Int.1985)).

The obviousness analysis focuses on the differences or changes between the claimed
subject matter of the application and the subject matter contained within the prior art references
at the time of the invention. Regardless of the simplicity of the changes, the claimed subject
matter will be patentable if the prior art fails to teach, suggest or motivate one of ordinary skill in
the art to modify what was known in the prior art, including any personal knowledge, to obtain
the claimed subject matter. In particular, the Federal Circuit has stressed that

[i]n a proper obviousness determination, '[w]hether the changes from the prior art are
'minor,' . . . the changes must be evaluated in terms of the whole invention, including
whether the prior art provides any teaching or suggestion to one of ordinary skill in
the art to make the changes that would produce the patentee's device.' This includes
what could be characterized as simple changes

In re Chu, 36 U.S.P.Q.2d 1089, 1094 (Fed. Cir. 1995) (citations omitted).

Especially in the case where the claimed subject matter relates to simple changes or
simple devices, it is of supreme importance to avoid the use of hindsight. The courts, including
the United States Court of Appeals for the Federal Circuit, have steadfastly condemned hindsight
application of prior art to find an invention *prima facie* obvious:

To imbue one of ordinary skill in the art with knowledge of the invention in suit,
when no prior art reference or references of record convey or suggest that

knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Al-Site Corp. v. VSI Int'l, Inc., 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999) (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed.Cir.1983)).

The standard of obviousness is not whether in hindsight, it seems elementary that someone would have combined these certain elements in the prior art to form the invention in question. See e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, [220 USPQ 303, 313] (Fed. Cir. 1983). Hindsight is almost always perfect. It is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art. Rather, there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention. *Winner Int'l Royalty Corp. v. Wang*, 48 U.S.P.Q.2d 1139, 1144 (D.C. D.C. 1998)

In view of this important principal, a “particular finding must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *In re Werner Kotzab*, Case. No. 99-1231 (Fed. Cir. June 30, 2000). “Broad conclusory statements standing alone are not ‘evidence.’” *Id.* (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q. 1614, 1617 (Fed. Cir. 1999)). In determining *prima facie* obviousness in the Final Rejection of Claims 1 to 6, it is submitted that the Examiner has violated the teaching or suggestion test and resorted to hindsight. As explained in more detail below, the obviousness rejection should therefore be reversed and the claims should be allowed to issue.

2. The Prior Art

Simon U.S. Patent No. 5,531,410 (Simon) is an example of the prior art cable-laying conduit similar to Muhlethaler, U.S. Patent No. 5,062,605, which is identified in the opening pages of the instant application. It discloses a cable way 1 that comprises a plurality of traverse wires 2 connected to a plurality of longitudinal wires 3 that are welded to the bottom of the

traverse wires 2.

The teachings of Hatch U.S. Patent No. 1,559,695 (Hatch) are directed to a bottle carrier that comprises a top frame member 1 and a bottom frame member 2 attached thereto. (Page 1, lines 35-39). The longitudinal wire members 5 of the bottom frame member 2 have offsets 7 in which the transverse bottom members 6 of the top frame member 1 are disposed. (Page 1, lines 50-58). A plurality of uprights 3,4, along with the wire members 5,6 form a plurality of compartments designed to carry bottles or cans. (Page 1, lines 66-68). Such bottles and cans have flat rigid bottom surfaces. Without the offsets 7, the bottles would rest upon only two contact points, i.e., the transverse bottom member 6, and the longitudinal bottom member 5 on either one side or the other side of the transverse bottom member 6. (Page 1, lines 70-76). The bottle would thus have a tendency to be inclined and rock between the two contact points provided by the longitudinal bottom member. Id.

Yake U.S. Patent No. 4,046,261 (Yake) discloses a dishwasher rack 1 made up of a plurality of longitudinally extending wire members 2 through 11, and a plurality of traverse wire members 12 through 20. (Col. 3, lines 41-43, 53-55). Two of the wire members 4 and 9 are affixed within a recessed portion so that the wires are not within the same plane as either the other longitudinal wire members 2-3, 5-8 and 10-11 or the traverse wire members 12 through 20. (Figs. 1, 3 and 11-14). One or more fences may be removably mounted within the rack structure to the longitudinally extending wire members 4 through 9. (Col. 6, lines 14-34).

3. ARGUMENT-OBVIOUSNESS

- i. The Rejection of Claims 1-3 as Obvious Over Simon in View of Hatch Under 35 U.S.C. §103(a) Should be Withdrawn

Applicant asserts that the cited references do not disclose or suggest the combination of all of the features recited in claims 1 through 3. Specifically, the cited references do not disclose or suggest a cable conduit as recited in claims 1 and 3.

As set forth above, Simon discloses the known prior art cable-laying conduit referred to in the present application. As acknowledged by the Examiner, Simon does not disclose the bends of the lengthwise wire. In order to get around this lack of disclosure, the Examiner refers to the teaching of the bottle carrier shown in Hatch; however, it is respectfully submitted that there is no teaching, suggestion or incentive to combine Simon and Hatch. When determining whether a claim is obvious in view of the prior art, "it is insufficient if prior art shows similar components unless it also contains some teaching, suggestion or incentive for arriving at the claimed structure." C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1351 (Fed. Cir. 1998) citing Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935, 15 USPQ.2d 1321, 323 (Fed. Cir. 1990). Rather, "the prior art must suggest to one of ordinary skill in the art the desirability of the claimed invention." Id. at 1352, citing Fromsom v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985).

In contrast to the teaching of Hatch, in the present invention, the cable conduit is not concerned with supporting bottles having flat rigid bottom surfaces, wherein the bottle will span across only one transverse bottom member. Rather, the present invention is concerned with the deformation of flexible or semi-rigid pipes or lines spanning across multiple cross-wise wires. In particular, the flexible or semi-rigid pipes or lines may deform under their own weight or by clamps. Such deformation is detrimental to the life and performance of the flexible or semi-rigid pipes or lines. In addition, there is always a desire to minimize the space required for the cable

conduit and the space savings provided by the claimed bends is significant, while such space savings would not be relevant in the bottle carrier. In addition, the claimed bends readily accommodate clamps and support members which are not utilized in the bottle carrier.

In cases of less technological inventions, it is especially important to consider all of the references in their entireties and all other factors, as “the danger increases that ‘the very ease with which the invention can be understood may prompt one to “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’” Ruiz v. A. B. Chance Co., 234 F.3d 654, 664, 57 USPQ.2d 1161 (Fed. Cir. 2000) (internal citations omitted). In the present case, the teaching of a wire bottle holder having a base so that the bottles will not tilt does not suggest or teach to one of ordinary skill in the art to amend the known cable conduit shown in Simon to get the claimed invention. Accordingly, it is respectfully submitted that the Examiner has resorted to hindsight in making the determination of obviousness.

As there is absolutely no teaching in the cited prior art to have a cable conduit having the limitations as set forth in Claims 1-3, it is submitted that the claims are patentably distinct over the prior art of record and should be allowed.

ii. The Rejection of Claims 4-6 as “Unpatentable” Over Simon in View of Hatch in Further View of Yake Under 35 U.S.C. §103(a) Should be Withdrawn

Claims 4 through 6 depend indirectly from claim 1, and therefore include all of the features of claim 1 plus other features. Thus, for the reasons mentioned above for overcoming the rejection of claim 1, Applicant submits the 35 U.S.C. § 103(a) rejection of claims 4 through 6 have also been overcome.

In addition, it is respectfully submitted that one of ordinary skill in the art, when looking for latticework for use with cables, would not look to a dishwasher rack (i.e., the teachings of Yake). Even if one were to consider a dishwasher rack to be analogous art to latticework trunking, there is no teaching or motivation to combine Yake with the other references and, in fact, it actually teaches away from the claimed invention as the longitudinal members 4,9 are not in the same plane as the traverse members 12-20. Accordingly, for these reasons, it is respectfully submitted that the claims are patentably distinct over the prior art of record and should be allowed.

1. Claim 4 is patentable over the prior art of record.

In addition to the reasons set forth above, it is respectfully submitted that the prior art does not teach or suggest a cable conduit having bends in the lengthwise wires having a width, measured in the first direction, that substantially corresponds to the thickness of a crosswire wire.

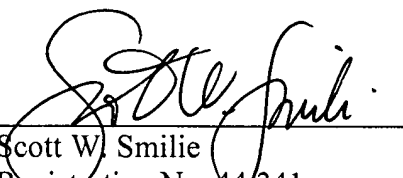
2. Claims 5 and 6 are patentable over the prior art of record.

In addition to the reasons set forth above, it is respectfully submitted that the prior art does not teach or suggest a cable conduit having bends in the lengthwise wires having a width, measured in the first direction, that is greater than twice the thickness of a crosswire wire. In particular, as set forth above, as Yake relates to a dishwasher rack having wires that do not lie in substantially the same plane, but are offset from one another, it is respectfully submitted that there is no teaching, suggestion or motivation in the references themselves, or in the knowledge of one of ordinary skill in the art, to combine the references.

It is submitted that the claims are allowable as now presented, and early and favorable treatment of this application is requested.

August 29, 2006
Customer No. 051500
PATZIK, FRANK & SAMOTNY LTD.
150 South Wacker Drive, Suite 900
Chicago, Illinois 60606
Telephone No.: 312-551-8300
Facsimile No.: 312-551-1101

Respectfully submitted,

By: 
Scott W. Smilie
Registration No. 44,341

VIII. CLAIMS APPENDIX

1. (Previously presented) Cable conduit running longitudinally in a first direction and comprising at least one substantially U-shaped section that has a bottom and two lateral flanges, said substantially U-shaped section extending over a certain length parallel to said first direction between two open ends, and defining an open and unobstructed upper area, and over a certain width at right angle to the first direction, said length being larger than said width, said cable conduit delimiting an interior volume designed to accommodate pipes or lines running longitudinally in the first direction, said cable conduit comprising rigid lengthwise wires running substantially parallel to the first direction and rigid crosswise wires running substantially at right angles to the first direction, the crosswise wires being fixed to the lengthwise wires toward the interior volume of the cable conduit, and each crosswise wire comprising a base portion belonging to the bottom of the cable conduit and two lateral branches belonging respectively to each lateral flange of the cable conduit, wherein at least the lengthwise wires belonging to the bottom of the cable conduit each comprise a succession of longitudinal portions connected by bends protruding away from the interior volume of the cable conduit, the bends of the lengthwise wires being designed to accommodate the base portions of the crosswise wires and being sized so that said base portions of the crosswise wires and the longitudinal portions of the lengthwise wires lie at substantially the same level.

2. (Previously presented) Cable conduit according to Claim 1, in which the longitudinal portions of the lengthwise wires are straight and parallel to the first direction.

3. (Previously presented) Cable conduit according to Claim 1, in which the base

portions of the crosswise wires and the longitudinal portions of the lengthwise wires are arranged in substantially the same plane.

4. (Previously presented) Cable conduit according to Claim 1, in which the bends of the lengthwise wires each have a width, measured in the first direction, that substantially corresponds to the thickness of a crosswire wire.

5. (Previously presented) Cable conduit according to Claim 1, in which the bends of the lengthwise wires each have a width, measured in the first direction, that is greater than twice the thickness of a crosswise wire.

6. (Previously presented) Cable conduit according to Claim 5, in which the bends in the lengthwise wires each have a flat bottom.

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDINGS APPENDIX

None



IN THE
UNITED STATES
PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: DUFOURG, Pierre-Stephane

CASE: 218728-000191

AMENDED
BRIEF ON
APPEAL

SER. NO.: 10/606,040

FILING DATE: June 23, 2003

FOR: LATTICEWORK TRUNKING

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

Date of Deposit: August 29, 2006

Express Mail Label No. EV096068147US

I hereby certify that this correspondence is being deposited with the United States Postal Service, "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on August 29, 2006.



Scott W. Smilie
Attorney for Applicant

Customer No. 051500
PATZIK, FRANK & SAMOTNY LTD.
150 South Wacker Drive
Suite 900
Chicago, Illinois 60606
Telephone (312) 551-8300
Facsimile (312) 551-1101

<u>Attorney</u>	<u>Reg. No.</u>
Max Shafat	31,422
Michael L. Kenaga	34,639
Scott Smilie	44,341
Sean S. Swidler	40,033
Jordan Herzog	38,182